

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Andres SANCHEZ Group Art Unit: No. 2642
Application No. : 09/407,174 Examiner: W. J. Deane, Jr.
Filed : September 28, 1999 Confirmation No.: 2402
For: : METHOD FOR MANAGING INFORMATION IN A TELEPHONE
AND TELEPHONE FOR MANAGING INFORMATION

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **Appeal Brief - Patents**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer dated March 3, 2008, the period for reply extending until May 5, 2008 (May 3, 2008 being a Saturday).

In the Examiner's Answer, the Examiner has maintained each ground of rejection and provides arguments in support thereof.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and is therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellant notes that they are addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On the Page 5, section 10 (*Response to Argument*), the Examiner asserts that “[o]f course the numbers downloaded by a user are related to at least incoming or outgoing calls. The recitation of “related to” is extremely broad. If the numbers are not related to one of incoming and outgoing calls, what is the point of storing them? Is it Appellant’s contention that a user of the Sussman device only downloads numbers that will never be used by a user?”

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Appellants submit that the applied art does not show each and every feature of the claimed invention.

While the Examiner somewhat incredulously addresses Appellant’s arguments, the Examiner has not shown that SUSSMAN in fact supports his theory. In fact, Appellant notes that SUSSMAN clearly and unambiguously discloses that memory 9 is utilized to receive and store a downloadable telephone directory. Further, Appellant notes SUSSMAN fails to disclose that memory 9 stores telephone data related to incoming and/or outgoing calls, only that the directory is stored.

Appellants acknowledge, once the directory is downloaded into memory 9, the user can select a number for calling. Moreover, while describing memory 10, SUSSMAN describes that telephone numbers may be stored that are not provided in the directory in memory 9, however, these number are stored by the user for later use. Thus, Appellant submits the applied document is not anticipatory of the claimed invention, since the only disclosure of storing numbers in

memory relates to numbers that *may* be called (in memory 9) or to numbers *to be* called (memory 10).

While the Examiner further asserts “it is noted that the claim does not recite that the system somehow captures the data of an incoming or outgoing call; only that the data is ‘related to’ incoming or outgoing calls. Note that the data stored in Sussman is “related to” incoming or outgoing calls.” While agreeing that the pending claims at issue do not recite that “the system somehow captures the data on an incoming or outgoing call,” Appellant again notes that SUSSMAN merely stores numbers to be called, and further notes the Examiner has not indicated how this storage of numbers *to be* called is related to storing data related to at least one of incoming and outgoing calls, as recited in Appellant’s claims. In other words, Appellants submit the Examiner’s arguments ignore the part of the recitation of *storing* telephone data related to at least one of incoming and outgoing telephone calls, as recited in Appellant’s claims (in terms of independent claim 1).

Thus, Appellant submits SUSSMAN fails to disclose a process that includes, *inter alia*, storing telephone data *related to at least one of incoming and outgoing telephone calls* in at least one of a public call and private call list. That is, SUSSMAN does not even suggest that incoming or outgoing calls are stored, only that the user can call numbers stored in the memories. Thus, SUSSMAN cannot anticipate the invention of at least independent claim 1.

Appellant also notes that SUSSMAN fails to disclose a device including, *inter alia*, a memory that stores telephone data related to at least one of incoming and outgoing telephone calls. As the applied art instead only describes memories into which data can be stored related to calls to be made, Appellant submits SUSSMAN fails to anticipate the invention recited in at least independent claim 11.

Further, Appellant submits SUSSMAN fails to disclose a process that includes, *inter alia*, creating a private list containing telephone data associated with the personal secret access code entered by the user, *the telephone data, composed of information related to incoming and outgoing telephone calls, collected and accessible only after entry of the associated personal secret access code*, and creating a public list accessible to all users during operation of the telephone which *contains telephone data, composed of incoming and outgoing telephone calls, collected and accessible prior to entering the personal secret access code*. As SUSSMAN does not disclose or even arguably suggest storing incoming or outgoing calls, but only storing numbers to be called by the user in the memories, the applied art cannot anticipate the invention of at least independent claim 16.

Still further, Appellant submits SUSSMAN fails to disclose a process including, *inter alia*, storing in the telephone, for each of the plurality of users, private telephone data *related to at least one of incoming and outgoing telephone calls in a respective private list*, wherein each respective private list is associated with a personal secret access code. Again, as SUSSMAN allows the storage of numbers to be called, but fails to disclose storing data related to incoming and/or outgoing calls, the art of record fails to anticipate the invention under 35 U.S.C. § 102(b).

Accordingly, Appellant requests that the Board reverse the Examiner's decision to reject the pending claims and to remand the application to the examining group for allowance of the same.

Second Issue

Appellant notes the Examiner has not identified any subject matter in AUSTIN that arguably discloses the subject matter noted above as deficient in SUSSMAN. Further, the Examiner has not identified any disclosure for modifying SUSSMAN in any obvious manner that

would render unpatentable the instant invention.

Therefore, Appellant submits, as AUSTIN fails to disclose the subject matter noted above as deficient in SUSSMAN, no proper combination of the applied art can render obvious the invention recited in the pending claims. Further, Appellant submits the applied art fails to disclosed any articulated reasoning for modifying SUSSMAN in any manner that would render unpatentable the instant invention.

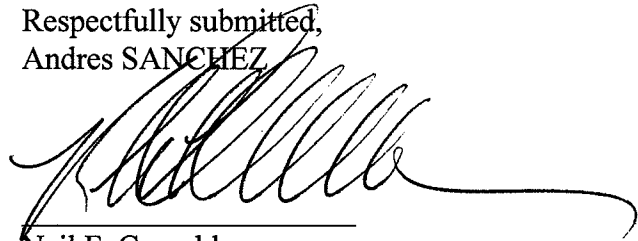
Accordingly, Appellant submits the rejection under 35 U.S.C. § 103(a) is likewise improper and should be reversed by the Board and remanded to the examining group for allowance.

CONCLUSION

For the reasons expressed above, Appellant respectfully requests that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellants respectfully request an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
Andres SANCHEZ



Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

May 5, 2008
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191